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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731
20277 7590 11/21/2007 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER HAN, QI	
			ART UNIT 2626	PAPER NUMBER
			MAIL DATE 11/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/593,060	EGUCHI ET AL.	
	Examiner	Art Unit	
	Qi Han	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

3. This communication is responsive to the applicant's amendment and RCE both filed on 09/12/2007. The applicant(s) amended claim 6 (see the amendment: page 4).

Response to Arguments

4. Applicant's arguments filed on 09/12/2007 with respect to the rejection of claim under 35 USC 112 and/or 103, have been fully considered but are moot in view of the new ground(s) of rejection (see below).

It is noted that even though the applicant's arguments regarding the rejection of claim under 35 USC 112 (see Remarks: page 8, paragraph 3 to page 11, paragraph 2) clarifies some

claimed limitations, the claims still remain certain problem that should be rejected under 35 USC 112 (see detail below).

It is also noted that the examiner takes out one reference (Fujita) from the combined prior art rejection, because the remaining previous cited references are still applicable for the prior art rejection with new ground (see detail below).

Specification and Drawing

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation “wherein, ...said controller... and controls said output unit so as to output the translated document data by groups, **each** group of the **translated** document data comprising **printed documents** in the **original language and printed documents** of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another” (in claim 17) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. Claims 1, 3-10 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "in a case where the second mode is set, said controller ... and controls said output unit so as to output **the translated document data** by groups, each group of the **translated document data comprising a printed document in the original language** and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another" is indefinite, because the context of the limitation is conflict itself in the way that the translated document data (or group of the **translated document data**) comprises a printed document in the original language, i.e. non-translated document.

Regarding claim 6, the limitation "in a case where the prescribed mode is set and the document data of the document includes a plurality of different languages, said controller ... and controls said output unit so as to output **the translated document data** by groups, each group of

the **translated** document data **comprising a printed document in the one of the original languages** and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another” is indefinite, because the context of the limitation is conflict itself in the way that the translated document data (or group of the **translated** document data) comprises a printed document in the original language, i.e. non-translated document.

Regarding claim 17, the limitation “wherein, ...said controller... and controls said output unit so as to output **the translated document data** by groups, **each** group of the **translated** document data comprising **printed documents in the original language and printed documents** of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another” is indefinite, because the context of the limitation is conflict itself in the way that the translated document data (or group of the **translated** document data) comprises a printed document in the original language, i.e. non-translated document. It is also unclear or confused that how “each group of the translated document data” comprises both “**printed documents in the original language and printed documents** of the translated document data ...”

Regarding claims 3-5, 7-10 and 18, the rejection is based on the same reason described for claims 1, 6 and 17, because the dependent claims include the same or similar problematic limitations as their independent claims respectively.

7. Claims 1, 3-10 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled

in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, the limitation “in a case where the second mode is set, said controller ... and controls said output unit so as to output **the translated document data** by groups, each group of the **translated document data comprising a printed document in the original language** and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another”, introduces new subject matter, because the limitation is not specifically described in or supported by the original specification.

Regarding claim 6, the limitation “in a case where the prescribed mode is set and the document data of the document includes a plurality of different languages, said controller ... and controls said output unit so as to output **the translated document data** by groups, each group of the **translated document data comprising a printed document in the one of the original languages** and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another”, introduces new subject matter, because the limitation is not specifically described in or supported by the original specification.

Regarding claim 17, the limitation “wherein, ...said controller... and controls said output unit so as to output **the translated document data** by groups, **each** group of the **translated document data comprising printed documents in the original language and printed documents** of the translated document data translated in each of the plurality of languages with

each of the printed documents being distinct from one another” introduces new subject matter, because the limitation is not specifically described in or supported by the original specification.

Regarding claims 3-5, 7-10 and 18, the rejection is based on the same reason described for claims 1, 6 and 17, because the dependent claims include the same or similar problematic limitations as their independent claims respectively.

Claim Rejections - 35 USC § 103

8. Claims 1, 4-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in view of Flores et al. (6,370,498 B1) hereinafter referenced as Flores.

As per **claim 1**, as best understood in view of the claim rejection under 35 USC 112 1st and 2nd (see above), Yamauchi teaches a translating apparatus comprising:

“translating means for translating document data of a document into another language” (Fig.1 and col. 7, lines 41-54, ‘translation unit 9’);

“an output unit for outputting the translated document data translated by said translating means in printed form” (col. 4, line 36 to col. 5, line 11, ‘output means for outputting said received document (including translated document data in printed form); Fig. 1, ‘bitmap exp 10’ and ‘plotter 11’, ‘PC/WS 12’; col. 7, lines 54-55, ‘the translating unit 9 supplies the output text data...for transfer to the personal computer 12’);

“a mode setting unit for setting the translating apparatus in a first mode or a second mode” (col. 4, lines 36-60, ‘wherein one of said first and second output means is selectively activated (mode setting)’);

“a controller”, (col.,7, lines 55-56, ‘the system of Fig. 1 includes a system controller’, which necessarily controls each unit, such as ‘OCR’, ‘translation’ and ‘outputs text data representing the result of translation’);

“wherein, in a case where the first mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, and controls said output unit so as to output the translated document data by language groups of printed documents, the language of each language group of printed documents consisting of one of the plurality of languages”, (col. 4, lines 39-45, ‘translating a received document, written in a first language, to a second, different language...output...in said second language... wherein one of said first and second output means is selectively activated (setting mode)’; col.,7, line 48, ‘outputs text data representing the result of translation’ (necessarily including printed document); col. 11, lines 40-45, ‘translating English to Japanese’ and/or ‘English to French...’; Fig. 24, showing different pages (interpreted as printed documents) in different language groups); and

“wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, and controls said output unit so as to output the translated document data by groups” (col. 4, lines 39-45; col. 7, line 48; col. 11, lines 40-45 and Fig. 24, same as stated above).

Yamauchi does not explicitly teach in the second mode, “each group of the <output> [translated] document data comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another.” However, the feature is well known in the art as evidenced by Flores who discloses apparatus and methods for multilingual

user access (title), comprising that 'the database stores translation of documents in multiple languages and a variety of formats' in computer-based system, 'user can choose to have the multiple translations' and 'to have a work displayed (output) in a written text in two or more separate languages' (Figs. 3-4 and col. 3, line 64 to col. 4, line 54, and col. 5, lines 27-57), viewing and choosing two or more languages presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B), so that one of ordinary skill in the art would recognize that the computer and database based multi-languages translation system disclosed by Yamauchi (as state above) would have capability of outputting multiple languages in different combinations, including forming and/or outputting printable documents by different groups, such as format (contents) groups, language groups), or repeated multi-language document group (i.e. common groups), because the computer/database based system necessarily or inherently provides the related translating, sorting, setting, manipulating and printing functions/tools for the printable documents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamauchi by providing translating document data in multiple languages and outputting (displaying or printing) the data by different groups of combination thereof (such as content groups, language groups, or common groups), suggested by Flores, for the purpose (motivation) of being beneficial to users presenting (or displaying) a written text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

As per **claim 4** (depending on claim 1), Yamauchi in view of Flores further teaches "said output unit includes a display for displaying the translated document data" (Yamauchi: Figs. 2 and col. 8, lines 33-34, 'display unit 33').

As per **claim 5** (depending on claim 1), Yamauchi in view of Flores further teaches “an operation unit for specifying a plurality of original languages and at least one language to be translated” (Yamauchi: Figs. 2 col. 7, lines 62, ‘system controller’, ‘input device 32 used by an operator’; col. 11, lines 40-45, ‘the translation unit achieves translation between other combination of languages...’; Fujita: col. 4, lines 4-8, ‘user can choose (specify) to have the multiple translations’; which necessarily includes specifying original languages and translated languages as claimed).

As per **claim 6**, as best understood in view of the claim rejection under 35 USC 112 1st and 2nd (see above), the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 6.

As per **claim 7** (depending on claim 6), Yamauchi further teaches “said output unit includes a printing device for printing the translated document data in a sheet” (Fig. 1, ‘plotter 11’).

As per **claims 8-9** (depending on claim 6), the rejection is based on the same reason described for claims 4-5, because the claims recite the same or similar limitations as claims 4-5 respectively.

As per **claim 10** (depending on claim 9), the rejection is based on the same reason described for claim 1, because the rejection for claim 1 covers the same or similar limitations as claim 10.

As per **claim 11**, the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 11.

As per **claims 12-13** (depending on claim 11), the rejection is based on the same reason described for claims 7-8 respectively, because the claims recite the same or similar limitations as claims 7-8 respectively.

As per **claim 14**, the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 6.

As per **claim 16** (depending on claim 14), the rejection is based on the same reason described for claim 4, because the claim recites the same or similar limitations as claim 4.

As per **claim 17**, as best understood in view of the claim rejection under 35 USC 112 1st and 2nd (see above), the rejection is based on the same reason described for claim 1, because it also reads on the limitations of claim 17.

As per **claim 18** (depending on claim 17), the rejection is based on the same reason described for claim 1, because the rejection for claim 1 covers the same or similar limitations as claim 18.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view of Flores as applied to claim 1, and further in view of Miyahara et al. (6,314,213 B1) hereinafter referenced as Miyahara.

As per **claim 3** (depending on claim 1), Yamauchi in view of Flores does not explicitly teach “said output includes a sorter for sorting printed sheets by the group”. However, this feature is well known in the art as evidenced by Miyahara who teaches using ‘a sorter 22’ for discharging ‘paper sheet’ (Fig.2) (col. 7, lines 28-29) and ‘a soft key which is used to sort, staple/sort’) (col. 8, line 12). Therefore, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to combine Yamauchi in view of Flores by providing a sorter and/or related sorting functionality, as taught by Miyahara, for the purpose of implementing user preferred function, like sorting the resultant sheets (Miyahara: col. 8, lines 4-13).

Conclusion

10. Please address mail to be delivered by the United States Postal Service (USPS) as follows:

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For

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general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh
November 17, 2007

A handwritten signature, possibly "JH", followed by the date "11/17/2007".